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OFFICE OF PETITIONS

Intervet/Schering-Plough
Animal Health
Patent Dept. K-6-1, 1990
2000 Galloping Hill Road
Kenilworth NJ 07033-0530

In re Application of :
Carcy, et al. :
Application No. 10/563,601 : ON APPLICATION FOR
Filed: May 4, 2006 : PATENT TERM ADJUSTMENT
Attorney Docket No. I-2003.005 US :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705" filed November 2 2009, which is properly treated under 37 CFR 1.705(b). Pursuant to applicants' duty of good faith and candor to the Office, applicants request that the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy. Applicants also set forth some argument as to the adjustment to the patent term on the basis that the Office will take in excess of three years to issue this patent, which is properly treated under 37 CFR 1.705(b).

Relative to the any assertion that the Office will take in excess of 3 years of the filing date to issue this patent, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE.**

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **GRANTED to the extent indicated herein.**²

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the 37 CFR 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

² It is noted that this "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705" was submitted, in part, as an advisement to the Office of an error in the calculation of the Patent Term Adjustment. The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

It is noted that the Office is not assessing the \$200.00 application fee under 37 CFR 1.18(e) for the portion of the REQUEST FOR RECONSIDERATION OF PATENT

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **twenty-one (21) days**. A copy of the updated PALM screen, showing the corrected determination, is enclosed.

On September 28, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment is 83 days. On November 2, 2009, applicants submitted the instant comment. Applicants disclose that the reduction to the patent term adjustment for applicant delay should be increased by 62 days because applicants filed a reply three months and 62 days after the final Office action was mailed April 16, 2009.

The application history has been reviewed and it has been determined that applicant should have been assessed a delay under 37 CFR 1.704(b)³ for filing a reply in excess of the three month period from the April 16, 2009, mailing date of the final Office action. On April 16, 2009, a final Office action was mailed. On September 16, 2009, applicants filed a response to the final Office action. Thus, applicant failed to engage in

TERM ADJUSTMENT UNDER 37 CFR 1.705" that is akin to a candor letter, but must assess the \$200.00 fee for the treatment of the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705" under 37 CFR 1.705(b).

³ 37 CFR 1.704(b) states:

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

reasonable efforts to conclude processing or examination of this application. Accordingly, the period of adjustment set forth in § 1.703 should have been reduced under 37 CFR 1.704(b) by 62 days, the number of days in the period beginning on the day after the date that is three months after the date of mailing of the final Office action, July 17, 2009, and ending on the date the reply was filed, September 16, 2009. A period of reduction of 62 days will be entered.

In view thereof, the determination of the patent term adjustment at the time of the mailing of the notice of allowance is twenty-one (21) days.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this specific matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Monday
Date: 4/19/2010

PALM INTRANET

-Time: 08:26:13

PTA Calculations for Application: 10/563601

Application Filing Date:	05/04/2006	PTO Delay (PTO):	139
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	56
Post-Issue Petitions:	0	Total PTA (days):	21
PTO Delay Adjustment:	-62		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
86	04/19/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		62	
65	09/28/2009	MAIL NOTICE OF ALLOWANCE			
64	09/24/2009	ISSUE REVISION COMPLETED			
63	09/24/2009	DOCUMENT VERIFICATION			
62	09/24/2009	EXAMINER'S AMENDMENT COMMUNICATION			
61	09/21/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
60	09/21/2009	NOTICE OF ALLOWABILITY			
57	09/18/2009	DATE FORWARDED TO EXAMINER			
56	09/16/2009	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
55	09/16/2009	NOTICE OF APPEAL FILED			
54	09/16/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	08/27/2009	EMAIL NOTIFICATION			
50	08/27/2009	MAIL ADVISORY ACTION (PTOL - 303)			
49	08/24/2009	ADVISORY ACTION (PTOL-303)			
45	07/21/2009	DATE FORWARDED TO EXAMINER			
44	07/16/2009	AMENDMENT AFTER FINAL REJECTION			
43	04/16/2009	ELECTRONIC REVIEW			
42	04/16/2009	EMAIL NOTIFICATION			
41	04/16/2009	MAIL FINAL REJECTION (PTOL - 326)			
40	04/13/2009	FINAL REJECTION			
36	01/29/2009	DATE FORWARDED TO EXAMINER			
35	01/15/2009	RESPONSE AFTER NON-FINAL ACTION		56	33
34	01/15/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			

33	08/20/2008	MAIL NON-FINAL REJECTION	4		28
32	08/18/2008	NON-FINAL REJECTION			
29	05/20/2008	DATE FORWARDED TO EXAMINER			
28	04/16/2008	RESPONSE AFTER NON-FINAL ACTION			
27	01/16/2008	MAIL NON-FINAL REJECTION			
26	01/07/2008	NON-FINAL REJECTION			
23	12/13/2007	DATE FORWARDED TO EXAMINER			
22	12/06/2007	RESPONSE TO ELECTION / RESTRICTION FILED			
21	11/16/2007	MAIL RESTRICTION REQUIREMENT	135		12
20	11/13/2007	REQUIREMENT FOR RESTRICTION / ELECTION			
18	08/12/2007	CASE DOCKETED TO EXAMINER IN GAU			
17	05/18/2007	CASE DOCKETED TO EXAMINER IN GAU			
16	03/06/2007	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
13	02/22/2007	PG-PUB ISSUE NOTIFICATION			
12	05/04/2006	371 COMPLETION DATE			
11	11/16/2006	APPLICATION DISPATCHED FROM OIPE			
10	05/04/2006	ADDITIONAL APPLICATION FILING FEES			
8	05/04/2006	PRELIMINARY AMENDMENTS			
6	05/04/2006	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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